

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on August 24, 2004, and the references cited therewith.

None of the claims are amended. Claims 11-16 are cancelled. Claims 1-10 and 17-20 are pending in this application.

§103 Rejection of the Claims

Claims 1-10 and 17-20 were rejected under 35 USC § 103(a) as being unpatentable over Becker et al. (U.S. Patent No. 4,849,590) in view of Kalvaitis et al. (U.S. Patent No. 4,791,530) and further in view of Laskaris et al. (U.S. Patent No. 5,225,782).

Claims 1-2 and 4-10

Regarding claims 1-2 and 4-10, Applicant respectfully submits that the Office Action did not make out a *prima facie* case of obviousness since there is no suggestion in the art to combine the references as suggested. In contrast, the primary references teach away from the asserted combination and the secondary reference, Laskaris, is not analogous to the field of invention.

In the Office Action, the Examiner asserts that it “would have been obvious to one of ordinary skill in the art at the time of the invention to provide the switch device of Becker et al. and Kalvaitis et al. with the steel flux barrier as taught by Laskaris et al., since the steel barrier of Laskaris et al. would provide the switch device of Becker et al. and Kalvaitis et al. with a magnetic shield.”

This reasoning is insufficient to support a case of *prima facie* obviousness. The Examiner must provide a specific reason to support an obvious rejection. *Ex parte Humphreys*, 24 USPQ2d 1255 (B.P.A.I. 1992). Here, the Office Action only states it would be obvious to provide the primary references with a magnetic shield. However, the Office Action does not provide any specific reason why it would have been obvious or what teaching in the art of transfer switches would suggest a transfer switch could use a magnetic shield. In the references themselves, there is simply no motivation to provide the devices of Becker et al. and Kalvatis with a magnetic shield. None of the cited references teach any need or motivation for a magnetic

flux barrier in a transfer switch. The Office Action has not submitted any evidence that one skilled in the art of transfer switches was concerned of this problem.

Moreover, the Laskaris reference is nonanalogous art in regard to the claimed invention. Analogous art is all art that is either in the field of technology of the claimed invention or deals with the same problem solved by the claimed invention even though outside the field of technology. *In re Wood*, 599 F.2d 1032, 202 USPQ 171 (CCPA 1979).

Laskaris et al. is directed to MR magnets for MR imaging systems. This is clearly not in the field of transfer switches. Moreover, the Laskaris reference is not concerned with the problem of minimizing magnetic interaction in a transfer switch. The Examiner points to Laskaris' magnetic shield 4, which includes end plates 22 and shell 6, as being a flux barrier. However, this subject matter is providing a shield around an MR magnet, which has nothing to do with a magnetic flux barrier for a transfer switch, as claimed.

Moreover, a factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would ... be led in a direction divergent from the path the applicant took. *In re Gurley*, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994). Here, Kalvaitis describes barriers 40, 42 as insulating barriers formed of fiberglass. (Col. 5, lines 4-10). Applicant notes that dielectric materials such as fiberglass have a relative magnetic permeability of 1 (about the same as air), making them ineffective at shunting magnetic fields away or providing a magnetic shield. This specifically teaches away from any sort of magnetic flux barrier for the Kalvaitis device.

Claims 2 and 4-10 include each limitation of their parent claim and are therefore not obvious in view of the cited references for the reasons given above. Reconsideration and allowance is respectfully requested.

Claim 3

Claim 3 includes similar limitations as claim 1, and Applicant believes claim 3 is not obvious in view of the cited references for the reasons given above. Reconsideration and allowance is respectfully requested.

Claims 17-20

Claims 17 - 20 include similar limitations as claim 1, and Applicant believes claims 17-20 are not obvious in view of the cited references for the reasons given above. Reconsideration and allowance is respectfully requested.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 359-3267 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743


Respectfully submitted,

LOREN L. RADEMACHER

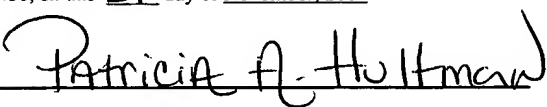
By his Representatives,

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